

~~ROUTING FOR DECISIONS OF BOARD OF APPEAL~~

	Initials	Date
QAS	<u>MB</u>	<u>7/1/04</u>
Director		
SPE	<u>LW</u>	<u>7/1/04</u>
Examiner		
Disposal Recorded by LIE		

Date of Decision	Serial Number	Examiner	Art Unit	Affirmed	Reversed
<u>5/28/04</u>	<u>08/581,050</u>	<u>Depungo</u>	<u>3611</u>	<input type="checkbox"/> 101 <input type="checkbox"/> 102 <input type="checkbox"/> 103 <input type="checkbox"/> 112 <input type="checkbox"/> other	<input type="checkbox"/> 101 <input type="checkbox"/> 102 <input type="checkbox"/> 103 <input type="checkbox"/> 112 <input type="checkbox"/> other

\*\*\*\*DUE DATE: \_\_\_\_\_

Comments:

Rehearing Request Denied!

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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 58

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte TAKAHISA UEDA

Appeal No. 2003-1780  
Application No. 08/581,050

HEARD: JANUARY 6, 2004

MAILED

MAY 28 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before COHEN, FRANKFORT, and PATE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a request for rehearing filed March 29, 2004 (hereafter "request"), appellant raises points that are asserted to have been misapprehended by this panel of the Board in its decision dated January (sic, February) 27, 2004. We respond to those points, as follows.

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Point (1)

It appears to us that appellant would have us now read into the broad language chosen for claim 2, i.e., a surface of a fiber yarn, a narrower description of the fiber surface as discerned from the drawings, i.e., an outer cylindrical surface of the fiber or the entire surface of the fiber. On appeal, we decline to read additional limitations into claim 2.<sup>1</sup> Appellant also offers an explanation of an intended narrower meaning of the term "surrounding"; relative to the "entire surface" of fibers. Again, we point out that we shall not read limitations into broad claim 2.<sup>2</sup>

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<sup>1</sup> Appellant refers to a POST HEARING MEMORANDUM in the request (page 2). Such a memorandum is not found in and is not of record in the application file. We note that the return of such a paper, not provided for in the Code of Federal Regulations, would be appropriate.

<sup>2</sup> Appellant references in the request (page 2) a sketch presented at the hearing, which sketch is not part of the record in the current application, and a copy of which sketch was not appended to any of the copies of the request filed by appellant, contrary to appellant's indication otherwise in the request. An earlier filed sketch denoted as Enclosure D, attached to appellant's brief (Paper No. 48), was acknowledged on page 3 of our decision (Paper No. 55). This panel of the Board continues to view that sketch as supporting our understanding of the broadly recited term "surrounding" and degree of bonding contact, as explained in the decision (pages 4, 5, and 8).

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Point (2)

Appellant's quote from pages 5 and 6 of our decision is in error in not accurately setting forth the language that it would "have been" obvious. Simply stated, claim 2 addresses "expanded graphite", not graphite particles, as argued. The sheets (and result) shown in Enclosure D are asserted by appellant as not the invention, yet appellant earlier acknowledged (brief, page 7) that expanded graphite may be a sheet of expanded graphite.

Point (3)

Appellant's intent as to what claim language should mean is not the dispositive issue on appeal. Instead, the broad language selected by appellant that is now present in the claims on appeal is at issue. Once again, we reiterate that claim 2 does not recite graphite particles, as appellant seems to believe. Further, as can be readily discerned from our underlying decision/opinion, we certainly did not dismiss out-of-hand the term "surrounding" in claim 2, contrary to appellant's point of view.

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In summary, appellant's request for rehearing has been granted to the extent that this panel of the Board has reconsidered its earlier decision, but has been denied with respect to making any changes in that decision, for the reasons articulated, supra.

REHEARING DENIED

IRWIN CHARLES COHEN )  
Administrative Patent Judge )  
CHARLES E. FRANKFORT ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
WILLIAM F. PATE, III ) AND  
Administrative Patent Judge ) INTERFERENCES

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BACON & THOMAS, PLLC  
625 SLATERS LANE  
FOURTH FLOOR  
ALEXANDRIA, VA 22314